

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

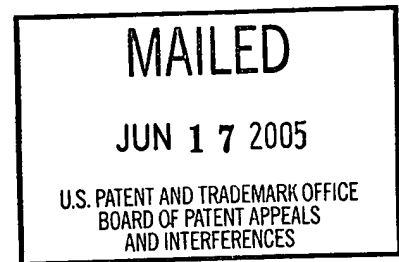
**UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Ex parte EILEEN MCFARLAND

Appeal No. 2003-1217  
Application No. 09/724,135

ON BRIEF



Before SCHEINER, GRIMES, and GREEN, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

**REQUEST FOR REHEARING<sup>1</sup>**

Appellant requests rehearing of the decision entered March 26, 2004. In that decision, we entered a new ground of rejection of claims 1-7 and 9, as anticipated by Curtin. Appellant asserts that the rejection is based on an erroneous interpretation of

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<sup>1</sup> On May 26, 2004, Appellant filed a paper styled "Reply After Decision on Appeal." The paper was apparently filed through the USPTO's Central Fax Center and routed to the examiner in Technology Center 1600. The paper notes that it was filed after an interview with the examiner (page 4) and requests "[r]econsideration and further examination" (page 1). However, the paper does not request any amendment to the claims, nor does it include a showing of facts that were not previously in the record; the paper merely presents argument directed to claim interpretation. The paper therefore did not present a basis on which the examiner could withdraw the rejection. See (then-applicable) 37 CFR § 1.196(b)(1) ("The new ground of rejection is binding upon the examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the examiner, overcomes the new ground of rejection."). "Argument as to any of the claims rejected by the Board which is not accompanied by an appropriate amendment or showing of facts as to those claims will be treated as a request for rehearing as to those claims." MPEP § 1214.01. We have treated Appellant's response as a request for rehearing.

the claims. We have considered Appellant's arguments but do not find them persuasive.

Appellant argues that the preamble of claim 1 should be given weight (beyond limiting the patients to whom the claimed process is applicable) because

[t]hroughout the prosecution history, Applicant has repeatedly relied on the preamble of the claims and the Specification disclosure detailing the diagnostic meaning of the method steps. Reliance upon the preamble during prosecution to overcome prior art "transforms the preamble into a claim limitation". Catalina v. Cool Savings.com, 289 F.3d 808.

Request for Rehearing, page 5.

We are not convinced that the recitations "aiding in a diagnosis of a predisposition to psychosis" and "screening for predisposition to psychosis" in the preambles of claims 1 and 6 limit the scope of the claims. Appellant has pointed to no specific point in the prosecution where she argued that the claims should be interpreted narrowly in view of their preambles. We have reviewed the prosecution and have not found any passages in which Appellant took the position that claims 1 and 6 were distinguished over the prior art by virtue of their preambles.

In addition, neither the Request for Rehearing nor the prosecution history shed any light on how Appellant sees the preambles as distinguishing claims 1 and 6 over the prior art. Appellant does not explain, for example, what additional step(s) would be required if the preamble language was given weight – if the preambles do not narrow the scope of the claims, they are not limitations.

Appellant also argues that the "wherein" clauses of claims 1 and 6 are entitled to weight in interpreting the claims:

the Board improperly treats the "wherein" clause as if it were a "whereby" clause. While some decisions determined that "whereby" clauses are

nonlimiting, Griffin v. Bertina discounts these cases as being fact specific. Griffin v. Bertina viewed the “wherein” clause as elaborating the meaning of the preamble and that the steps set forth have “little meaning or utility unless they are place[d] within the context of the diagnosis...” Id. 1034. Thus, “wherein” clauses that relate back to and clarify what is required by the claim give meaning and purpose to the manipulative steps.

Request for Rehearing, page 5.

We do not agree that Griffin requires giving weight to the “wherein” clauses in the instant claims. The Griffin court had this to say about the “wherein” clause at issue in that case:

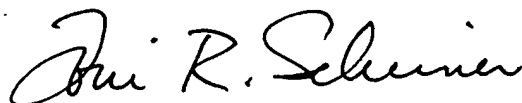
Griffin cites other cases in which the court determined that “whereby” clauses were nonlimiting. Aside from the fact that “wherein” is an adverb and “whereby” is a conjunction, those cases are all fact-specific, and what is clear here is that the “wherein” clauses are a necessary part of this count.

285 F.3d 1029, 1034, 62 USPQ2d 1431, 1434 (Fed. Cir. 2002).

Thus, all Griffin really stands for on this point is that claims involving “wherein” or “whereby” clauses must be considered on a case-by-case basis. As discussed in our previous opinion (pages 8-9), the facts of this case indicate that the “wherein” clauses of claims 1 and 6 do not limit the scope of those claims: in the claims as written, the “wherein” clauses do not require the person carrying out the method to perform any additional manipulative step(s), nor do they even require recognition of a relationship between the presence of anti-Cw antibody and predisposition to psychosis.

We have reconsidered our previous opinion in light of Appellant's request for rehearing but decline to make any changes to the opinion.

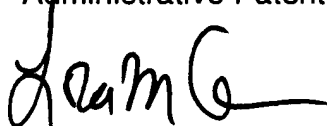
REHEARING DENIED



Toni R. Scheiner  
Administrative Patent Judge



Eric Grimes  
Administrative Patent Judge



Lora M. Green  
Administrative Patent Judge

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